REMARKS

Claims 1-3, 5-12, 14-21 and 23-28 were previously pending, of which claims 5, 14 and 23 have been canceled; therefore, claims 1-3, 6-12, 15-21 and 24-28 are currently pending. Claims 1, 10, 19 and 28 have been amended. No new matter has been added by the amendments. Reconsideration and allowance of the pending claims are respectfully requested in light of the foregoing amendments and the following remarks.

Rejections Under 35 U.S.C. §103

Claims 1-3, 6-12, 15-21 and 24-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,681,323 to Fontanesi et al (hereinafter "Fontanesi") in view of U.S. Patent No. 6,351,850 to van Gilluwe et al (hereinafter "van Gilluwe"). Applicants respectfully traverse the Examiner's position for the following reasons.

As the PTO recognizes in MPEP §2142:

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

1. Even when combined, the references do not teach the claimed subject matter.

The cited references cannot be applied to reject independent claims 1, 10, 19 and 28, as amended, under 35 U.S.C. §103(a) because, even when combined, the references do not produce the claimed subject matter.

Claim 1, as amended, recites, in part:

> in response to a size of a storage device and a size of an image to be stored on the storage device, identifying a sector offset on the storage device such that storage of the image on the storage device at the sector offset will result in the image being stored at or near a highest address of the storage device;

The Examiner concedes that "Fontanesi does not expressly disclose . . . in response to a size of a storage device, identifying a sector offset on the storage device." The Examiner goes on to state that, given that Fontanesi discloses partitioning, formatting, storing, and installing in connection with a storage device, "[i]nherently, Fontanesi must inherently identify a location on the storage device with which to perform each of these operations." Even assuming *arguendo* that the Examiner's position is not incorrect, the cited portions of Fontanesi (i.e.,

column 6, lines 42-58, column 6, line 59, through column 7, line 4; and column 7, lines 5-25) clearly fail to teach "identifying a sector offset on the storage device such that storage of the image on the storage device at the sector offset will result in the image being stored at or near a highest address of the storage device" in response to a size of a storage device and a size of an image to be stored on the storage device, as clearly recited in independent claim 1. The deficiencies of Fontanesi in this regard are not remedied by Gilluwe, which is cited by the Examiner as teaching identifying the number of sectors and number and location of each partition on a storage device, and determining the size of each partition and the amount of free space in each partition when identifying the location thereof.

In view of the foregoing, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 1, as well as claims 2, 3 and 6-9 dependent therefrom, under 35 U.S.C. §103 should be withdrawn and those claims allowed. Each of independent claims 10, 19 and 28 includes limitations similar to those of claim 1 and is therefore also deemed to be in condition for allowance for at least the same reasons as claim 1. Claims 11, 12, 15-18, 20, 21 and 24-27 depend from and further limit independent claims 10 and 19 and are therefore also deemed to be in condition for allowance by virtue of dependency.

2. The combination of references is improper.

Assuming, *arguendo*, that when combined, the references teach the claimed subject matter (which is clearly <u>not</u> the case, as demonstrated above), there is another, mutually exclusive, and compelling reason why the references cannot be applied to reject the claims under 35 U.S.C. §103.

§2142 of the MPEP also provides:

> . . . The examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. . . . The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither Fontanesi, which teaches a system and method for automatically installing an initial software configuration, nor van Gilluwe, which teaches a system and method for installing a computer operating system, discloses or even suggests the desirability of combining the references in such a manner as to teach the embodiments recited in the independent claims. Moreover, neither reference provides any incentive or motivation for the combination.

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

The MPEP further provides at §2143.01:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In this context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the independent claims. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Conclusion

For at least the reasons set forth in detail above, independent claims 1, 10, 19 and 28 are deemed to be in condition for allowance. Claims 2, 3, 6-9, 11, 12, 15-18, 20, 21 and 24-28 depend from and further limit independent claims 1, 10, 19 and 28, and are therefore also deemed to be in condition for allowance. Accordingly, Applicants respectfully request that the Examiner withdraw the pending rejections and issue a formal notice of allowance.

An early formal notice of allowance of all pending claims is respectfully requested.

Respectfully submitted,

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